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Attorney Docket No. P23936

In re application of: **Kazutoyo MAEHIRO**

Mail Stop Amendment
Group Art Unit : 2152

Application No. : 09/820,530

Filed : March 29, 2001

Examiner : Chad ZHONG

For : **METHOD AND APPARATUS FOR JOINING ELECTRONIC CONFERENCE**

Mail Stop Amendment

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief-Patent
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

Transmitted herewith is an **Amendment Appeal Brief under 37 C.F.R. § 41.37** in the above-captioned application.

- ☐ Small Entity Status of this application under 37 C.F.R. 1.9 and 1.27 has been established by a previously filed statement.
☐ A verified statement to establish small entity status under 37 C.F.R. 1.9 and 1.27 is enclosed.
☐ A Request for Extension of Time.
☒ No additional fee is required.

The fee has been calculated as shown below:

Claims After Amendment	No. Claims Previously Paid For	Present Extra	Small Entity		Other Than A Small Entity	
			Rate	Fee	Rate	Fee
Total Claims: 9	*20	0	x25=	\$	x 50=	\$0.00
Indep. Claims: 4	**4	0	x100=	\$	x200=	\$0.00
Multiple Dependent Claims Presented			+180=	\$	+360=	\$0.00
Extension Fees for ____ Month(s)				\$		\$0.00
Total:				\$	Total:	\$0.00


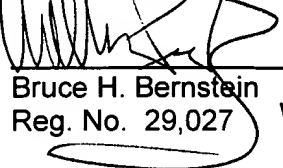
☐ Please charge my Deposit Account No. 19-0089 in the amount of \$ ____.

☒ A check in the amount of \$ ____ to cover the filing/extension fee is included.

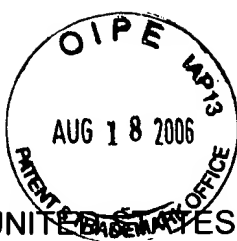
☒ The U.S. Patent and Trademark Office is hereby authorized to charge payment of the following fees associated with this communication or credit any overpayment to Deposit Account No. 19-0089.

☒ Any additional filing fees required under 37 C.F.R. 1.16.

☒ Any patent application processing fees under 37 C.F.R. 1.17, including any required extension of time fees in any concurrent or future reply requiring a petition for extension of time for its timely submission (37 C.F.R. 1.136(a)(3)).


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P23936.A09



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Kazutoyo MAEHIRO Confirmation No.: 5426
Appln. No. : 09/820,530 Examiner: Philip C. LEE
Filed : March 29, 2001 Group Art Unit: 2152
For : METHOD AND APPARATUS FOR JOINING ELECTRONIC
CONFERENCE

AMENDED APPEAL BRIEF UNDER 37 C.F.R. § 41.37

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop Appeal Brief-Patents
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401 Dulany Street
Alexandria, VA 22314

Sir :

This Amended Appeal Brief is being submitted in response to the Notification of Non-Compliant Appeal Brief (37 CFR 41.37) mailed August 8, 2006, which set a one month period for response. The Notification of Non-Compliant Appeal Brief asserted non-compliance based on two objections by the Examiner, that the brief did not mention an After Final Reply that was filed January 17, 2006, and that the brief did not provide a summary of dependent claims 3 and 7, which were argued separately in the brief. This Amended Appeal Brief fully addresses and responds to both objections.

This appeal is from the Examiner's rejection of claims 1 – 9, as set forth in the Official Action of September 1, 2005.

A Notice of Appeal was filed on March 17, 2006, in response to the Official Action dated October 17, 2005, and subsequent Advisory Action dated February 9, 2006, submitted in response to the Response after Final, filed within the three-month period for

response on January 17, 2006.

The requisite fee for filing a Notice of Appeal under 37 C.F.R. 41.20 (b)(1) was paid on January 3, 2006. The requisite fee for filing a brief in support of appeal under 37 C.F.R. 41.20 (b)(2) was paid May 17, 2006 with the concurrent filing of the Appeal Brief. However, if for any reason the necessary fees are not associated with this file or the attached fee is inadequate, the Commissioner is authorized to charge any necessary fees to Deposit Account No. 19-0089.

(1) REAL PARTY IN INTEREST

The real party in interest is Kabushiki Kaisha Square Enix (also trading as Square Enix Co., LTD), as established by a Merger recorded in the U.S. Patent and Trademark Office on August 7, 2003, at Reel 014630 and Frame 0765.

(2) RELATED APPEALS AND INTERFERENCES

No related appeals and/or interferences are pending.

(3) STATUS OF THE CLAIMS

Claims 1 - 9 stand rejected. Claim 10 has been canceled. A copy of claims 1 – 9, the rejections of which are appealed, is attached as an Appendix to this brief.

(4) STATUS OF THE AMENDMENTS

An After Final Reply was filed on January 17, 2006, with arguments against the rejections made in the Final Official Action mailed October 17, 2005 and a request for withdrawal of the same by the Examiner. However, no amendments have been submitted

subsequent to the Final Official Action mailed October 17, 2005.

(5) SUMMARY OF THE CLAIMED SUBJECT MATTER

Initially, appellants note that the following descriptions are made with respect to the independent claims and include references to particular parts of the specification. As such, the following are merely exemplary and are not a surrender of other aspects of the present invention that are also enabled by the present specification and that are directed to equivalent structures or methods.

The present invention relates to video game machine operations. More specifically, the present invention relates to easily opening an area on a database for storing electronic chat messages, as well as joining the chat by accessing the area on the database. (Page 1, lines 10 – 14) Initially, a chairman's terminal receives an opening response signal from a server, in response to an opening request from the chairman's terminal, indicating that the area has been set on the database. (Page 9, lines 24-27) The opening response signal includes an ID number for allowing the server to identify the area on the database, (Page 12, lines 22-24) Setup information, such as a password and chat name are stored on a chairman's video game terminal. (Page 11, lines 25 - 27; and Fig. 3) The chairman creates an invitation message including the stored setup information. In response to a single instruction from the chairman, the chairman's video game terminal sends the invitation message. (Page 10, lines 8 - 21; Page 12, lines 15 – 26; and Figs. 4 and 5) The invitation signal contains the ID number. (Page 12, lines 11-12) A video game terminal of the guest receives the invitation message, and creates an access request signal that includes the setup information. (Page 10, lines 11 – 15; and Fig. 6), including the ID

number contained in the invitation signal. (Page 13, line 25 to page 14, line 1) The video game terminal of the guest transmits the access request signal to the database, solely in response to an instruction from the guest. (Page 13, lines 19 – page 14, line 11)

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether Claims 1 – 9 are properly rejected under 35 U.S.C., 103(a) as obvious over RIDDLE et al. (U.S. Patent No. 6,311,197) in view of BATTLENET.

(7) ARGUMENT

Claims 1 - 9 Are Not Obvious over RIDDLE in View of BATTLENET under 35

U.S.C. §103(a)

The References Relied upon by the Examiner Are Non-analogous

The references relied upon by the examiner are non-analogous. Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986); *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979).

RIDDLE is related to teleconferencing in a peer to peer environment. See Figs. 1, 10, 32, 35a, and 35b. That is, voice and data are streamed in real time between endpoints. Real time applications, such as teleconferencing, do not store data streams

during a transmission because such storage would delay the transmission and thus lose the desired real time functionality required for teleconferencing.

In contrast, the present invention relates to the well known chat, in which messages are stored on a database. See Fig. 2. Chat rooms (or areas on the database) store messages that are viewed by users. No real time requirements exist. Moreover, the present invention operates in a client server architecture, rather than a peer to peer architecture.

The RIDDLE system is not pertinent to the problem with which the inventors are involved. The inventors solved the problems associated with using video game terminals for chat. Typically, video game terminals, such as a Sony Playstation II, have a very limited input system, e.g., no keyboard or mouse. As discussed on page 14, lines 1 – 11, the present invention eliminates the cumbersome operations typically entailed in setting up and joining a chat room. Such cumbersome procedures are particularly problematic when using video game terminals, which have a limited input system.

RIDDLE, on the other hand, pertains to general purpose computers that have standard input systems. See col. 4, lines 13 – 23. In fact, the video conference setup of RIDDLE is quite cumbersome (as discussed in more detail below) and is entirely unconcerned with simplification of the setup procedures.

There Is No Motivation to Combine PERRIN et al. or PETERSON et al. with TUFTE

Even if the references are considered analogous (which they are not), there is no suggestion, motivation, incentive, or reason to combine them in the manner proposed by

the examiner, except that provided in appellant's specification. [T]he record must provide a teaching, suggestion, or reason to substitute computer-controlled valves for the system of hoses in the prior art. The absence of such a suggestion to combine is dispositive in an obviousness determination. See *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 886-87, 8 USPQ2d 1468, 1475 (Fed. Cir. 1988).

It is submitted that the reasoning provided for the proposed combination is improper. RIDDLE does not pertain to video game terminals, video games or chat. Thus, there would be no need within the system of RIDDLE to allow for centralized chat rooms (areas on a database) for video game terminals to set up games, contrary to the Examiner's assertions. Thus, no motivation for the proposed combination exists.

In the Advisory Action, the examiner misplaces his reliance upon the Board decision *Obiaya*. In the present application, the advantages of applicant's system would not flow naturally from RIDDLE because, as mentioned above, RIDDLE is not faced with the problem of cumbersome input from video game terminals, and also because RIDDLE is unrelated the chat messaging, and access to the chat room (database area). Contrary to the examiner's assertions, RIDDLE does not relate to a chat system or a centralized chat system (as explained in more detail below). One looking at the chat system of BATTLENET would have no reason whatsoever to consult with a reference directed to teleconferencing (entirely unrelated to chat) between general purpose computers.

The Combination of RIDDLE, and BATTLENET Does Not Teach or Suggest All of the
Limitations of Claim 1 - 9

(1) Claim 1

Even if combined, the references fail to teach all the limitations, namely: Claim 1 requires an electronic chat joining method in which a chairman who opens an electronic conference sets an area on a database for storing chat messages. Guests who join the electronic chat send requests for access to the area to the database from video game terminals. The method includes storing setup information for setting the database area in a chairman's video game terminal . . . transmitting from the guest's video game terminals to the database, access request signals solely in response to each guests instruction. The database area stores chat messages that are sent to and from the video game terminals. An example of a message sequence is shown in Fig. 2.

In contrast the applied references do not teach or render obvious to one having ordinary skill in the art a method including storing setup information for setting the database area in a chairman's video game terminal . . . and transmitting from the guest's video game terminals to the database, access request signals solely in response to each guests instruction, (step 208 Fig. 2) the database area storing chat messages that are sent to and from the video game terminals. Rather, RIDDLE is limited to peer to peer communications that do not include sending information to a database area that stores chat messages.

In the Advisory Action, the examiner argues that the database is not recited in the claims. Applicants note that claim 1 recites the database at no less than four locations. Applicants do not understand how the limitation can be overlooked by the examiner.

The examiner then refers to col. 7, lines 39 – 67, col. 13, lines 50 – 67, and col. 14, lines 5 – 10, as well as Fig. 2 to show a database that stores chat messages. Col. 7 primarily discusses information that is stored at one endpoint and then sent to another endpoint. No discussion of chat message storing exists, as the system is a point to point real time teleconferencing system, not a chat messaging system. Cols. 13 and 14 briefly mention a conference server. However, no area of the conference server stores chat messages, as expressly claimed. Rather, the conference server merely manages a conference and does not store chat messages. RIDDLE provides very little information about the conference server. Fig. 2 shows non-media information. Where it is stored is not explained by RIDDLE. Importantly, there is no discussion or suggestion of a database that stores chat data, the guest video game terminals transmitting access request signals to the database.

Claim 1 also recites giving an instruction from the chairman's video game terminal for transmission of the invitation message and transmitting from the chairman's video game terminal an invitation signal . . . based on only the instruction. The examiner argues in the Advisory Action that RIDDLE teaches a database server hosting the conference chat in col. 13, lines 50 – 67, col. 14, lines 5 – 10, col. 5, lines 30 – 35. Initially, applicants must point out that the examiner's colloquial use of "chat" is inconsistent with the claimed "chat." As is well known in the art and consistent with applicant's entire specification, the claimed "chat" relates to storage of text messages on a database area, i.e., chat room. Although the Interview Summary states that RIDDLE teaches voice and text chat between two computer systems, applicants strenuously disagree with this characterization of the interview and

maintain the position that the colloquial use of chat is significantly different from the claimed chat.

Now turning to the portions of RIDDLE upon which the examiner relied, applicant notes that although a member ready event can be sent, more than a single instruction is required from the teleconference participant. Applicant notes that col. 11, lines 33 – 41 of RIDDLE describe the member sending either a Capabilities message or an Auxiliary message. The member then sends a Hello message followed by a Call message or a Join message. The passage describes the numerous actions the member must take. Because video game terminals are not part of the RIDDLE system, reducing user input does not appear to be an object of RIDDLE. Thus, it is submitted that the disclosed messaging requires numerous activities by the members. In contrast, the claims recite action taken “*solely* in response to ...” It is believed that transmitting the access request signal and transmitting the invitation signal *solely* in response to the instructions of the chairman/guest is not taught or suggested by RIDDLE.

The examiner tried to slip in the assertion that RIDDLE supports text chat in the Interview Summary mailed January 17, 2006. The examiner has never provided any support for this assertion. In fact, throughout the RIDDLE specification, real time teleconferencing, is clearly discussed.

The examiner only relies upon BATTLENET to show video game terminals. Thus, BATTLENET does not supply the deficiencies of RIDDLE, which are discussed above.

It is submitted that no proper combination of RIDDLE and BATTLENET anticipates or renders obvious all of the limitations recited in claim 1.

(2) Claim 2

Claim 2 depends from claim 1. Appellants additionally submit that claim 2 is allowable, at least for the reason that this claim depends from claim 1, and because claim 2 recites additional features that further define the present invention.

Accordingly, at least for each and all of the reasons set forth above, appellants submit that the rejection of the invention recited in claim 2 should be reversed.

(3) Claim 3

Claim 3 further defines the method as including receiving at the chairman's terminal, an opening response signal from the server (database) the opening response signal indicating that the area has been set in the database the opening response signal comprising an ID number for allowing the server to identify the database area, transmitting from the chairman's terminal the invitation signal containing the ID number, and adding the ID number contained in the invitation signal to the access request signal.

The proposed combination does not teach or suggest these limitations. The examiner relies upon col. 5, lines 29 – 35 and col. 7, lines 60 – 67 to support the rejection of claim 3. However, those passages, as well as the rest of RIDDLE lack the claimed area set on the database (i.e., chat room). Thus, RIDDLE does not teach or suggest receiving a signal indicating that the area has been set in the database. Not having any such signal, RIDDLE of course does not have an ID of the database area (i.e., chat room ID), and thus does not transmit the ID in the invitation signal nor add the ID to the access request signal.

Accordingly, at least for each and all of the reasons set forth above, appellants submit that the rejections of the invention recited in claim 3 should be reversed.

(4) Claim 4

Claim 4 depends from claim 3. Appellants additionally submit that claim 4 is allowable, at least for the reason that this claim depends from claim 3, and because claim 4 recites additional features that further define the present invention.

Accordingly, at least for each and all of the reasons set forth above, appellants submit that the rejections of the invention recited in claim 4 should be reversed.

(5) Claim 5

Claim 5 is directed to an electronic chat joining system comprising a chairman's video game terminal and guests' video game terminals. In claim 5, the chairman's video game terminal comprises a storage that stores setup information for setting an area on a database. The chairman's video game terminal also includes an instruction device that gives an instruction for transmission of the invitation message, and an invitation signal transmitter that transmits an invitation signal to the guests' video game terminals solely in response to the instruction. The guests' video game terminals include a request signal transmitter that transmits to the database, the access request signals . . . solely in response to each guest's instruction. The proposed combination does not teach or suggest these limitations, for similar reasons as noted above with respect to claim 1.

Accordingly, at least for each and all of the reasons set forth above, appellants submit that the rejection of the invention recited in claim 5 should be reversed.

(6) Claim 6

Claim 6 depends from claim 5. Appellants additionally submit that claim 6 is allowable, at least for the reason that this claim depends from claim 5, and because claim 6 recites additional features that further define the present invention.

Accordingly, at least for each and all of the reasons set forth above, appellants submit that the rejection of the invention recited in claim 6 should be reversed.

(7) Claim 7

Claim 7 further defines the chairman's terminal as including a receiver that receives an opening response signal from the server (database) the opening response signal indicating that the area has been set in the database the opening response signal comprising an ID number for allowing the server to identify the database area. The invitation signal transmitter is further defined as transmitting the invitation signal comprising the ID number, and the access request signal source is defined as adding the ID number contained in the invitation signal to the access request signal.

The proposed combination does not teach or suggest these limitations. The examiner relies upon col. 5, lines 29 – 35 and col. 7, lines 60 – 67 to support the rejection of claim 7. However, those passages, as well as the rest of RIDDLE lack the claimed area set on the database (i.e., chat room). Thus, RIDDLE does not teach or suggest receiving a signal indicating that the area has been set in the database. Not having any such signal, RIDDLE of course does not have an ID of the database area (i.e., chat room ID), and thus does not transmit the ID in the invitation signal nor add the ID to the access request signal.

Accordingly, at least for each and all of the reasons set forth above, appellants

submit that the rejections of the invention recited in claim 7 should be reversed.

(8) Claim 8

Claim 8 depends from claim 7. Appellants additionally submit that claim 8 is allowable, at least for the reason that this claim depends from claim 7, and because claim 8 recites additional features that further define the present invention.

Accordingly, at least for each and all of the reasons set forth above, appellants submit that the rejections of the invention recited in claim 8 should be reversed.

(9) Claim 9

Claim 9 is directed to a recording medium having programs recorded thereon, the programs controlling video game terminals in an electronic conference joining system in which a chairman who opens an electronic conference sets an area on a database. The database area stores chat messages that are sent to and from video game terminals. Guests who join the electronic conference send requests for access to the area to the database from video game terminals of the guests. The program causes a computer to store setup information for setting the area on a database. The program also gives an instruction for transmission of the invitation message, and transmits an invitation signal to the guests' video game terminals solely in response to the instruction. The recording medium has a program for causing the guests' video game terminals to transmit to the database, the access request signals . . . solely in response to each guest's instruction. The proposed combination does not teach or suggest these limitations, for similar reasons as noted above with respect to claim 1.

Accordingly, at least for each and all of the reasons set forth above, appellants submit that the rejection of the invention recited in claim 9 should be reversed.

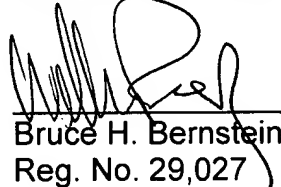
(8) **CONCLUSION**

Accordingly, for all the above reasons, appellants submit that the rejections of claims 1 - 9 under 35 U.S.C. § 102(a) are inappropriate and unsupported by RIDDLE and BATTLENET. Therefore, appellants respectfully request that the decision of the Examiner to reject claims 1 - 9 under 35 U.S.C. § 103(a) be reversed, and that the application be returned to the examiner for withdrawal of the rejection and an early allowance of claims 1 - 9 on appeal.

Appellants respectfully submit that each and every pending claim of the present application meets the requirements for patentability under 35 U.S.C. § 103, and that the present application and each pending claim are allowable over the prior art of record.

Should there be any questions, any representative of the U.S. Patent and Trademark Office is invited to contact the undersigned at the below-listed telephone number.

Respectfully submitted,
Mitsuo YOSHIOKA



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CLAIMS APPENDIX

1. An electronic chat joining method in which a chairman who opens an electronic conference sets an area on a database for storing chat messages, and in which guests who join said electronic chat send requests for access to said area to the database from video game terminals of the guests, the method comprising:

storing setup information for setting said area in a storage section of a chairman's video game terminal,

creating from the chairman's video game terminal an invitation message comprising said setup information stored in said storage section,

giving an instruction from the chairman's video game terminal for transmission of said invitation message,

transmitting from the chairman's video game terminal an invitation signal comprising said setup information to said guests' video game terminals based on only said instruction,

receiving at the guests' video game terminals said invitation signal and obtaining said setup information,

creating at the guests' video game terminals access request signals comprising said setup information, and

transmitting from the guests' video game terminals to said database, said access request signals solely in response to each guest's instruction,

the database area storing chat messages that are sent to and from the video game terminals.

2. The electronic conference joining method according to claim 1, wherein said setup information comprises at least one of a name of said electronic conference and a code number for accessing said area of said database.

3. The electronic conference joining method according to claim 1, further comprising:

receiving at the chairman's terminal, an opening response signal from said server, said opening response signal indicating that said area has been set in said database, said opening response signal comprises an ID number for allowing said server to identify said area of said database,

transmitting from the chairman's terminal said invitation signal containing said ID number, and

adding said ID number contained in said invitation signal to said access request signal.

4. The electronic conference joining method according to claim 3, wherein said setup information comprises at least one of a name of said electronic conference and a code number for accessing said area of said database.

5. An electronic chat joining system in which a chairman who opens an electronic conference sets an area on a database, the database area storing chat messages that are sent to and from video game terminals and in which guests who join said electronic conference send requests for access to said area to the database from video game terminals of the guests,

the system comprises a chairman's video game terminal comprising a storage that stores setup information for setting said area, an invitation message creator that creates an

invitation message comprising said setup information stored in said storage, an instruction device that gives an instruction for transmission of said invitation message created by the invitation message creator, and an invitation signal transmitter that transmits an invitation signal comprising said setup information to said guests' video game terminals solely in response to said instruction from the instruction device, and

said guests' video game terminals comprising a setup information retriever that receives said invitation signal and obtains said setup information, an access request signal source that creates an access request signals comprising said setup information obtained by the setup information retriever, and a request signal transmitter that transmits to said database, said access request signals created at said access request signal source solely in response to each guest's instruction.

6. The electronic conference joining system according to claim 5, wherein said setup information comprises at least one of a name of said electronic conference and a code number for accessing said area of said database.

7. The electronic conference joining system according to claim 5, wherein said chairman's terminal further comprises a receiver that receives an opening response signal from said server, said opening response signal indicating that said area has been set in said database,

said opening response signal comprising an ID number for allowing said server to identify said area of said database,

wherein said invitation signal transmitter transmits said invitation signal comprising said ID number, and

wherein said access request signal source adds said ID number contained in said invitation signal to said access request signal.

8. The electronic conference joining system according to claim 7, wherein said setup information comprises at least one of a name of said electronic conference and a code number for accessing said area of said database.

9. A recording medium having programs recorded thereon, said programs controlling video game terminals in an electronic conference joining system in which a chairman who opens an electronic conference sets an area on a database, the database area storing chat messages that are sent to and from video game terminals and in which guests who join said electronic conference send requests for access to said area to the database from video game terminals of the guests,

said recording medium being readable by a computer and having, to control said chairman's video game terminal, a program recorded thereon for causing said computer to store setup information for setting said area in a storage section, create an invitation message comprising said setup information stored in said storage section, give an instruction for transmission of said invitation message, and transmit an invitation signal containing said setup information to said guests' terminals solely in response to said instruction,

said recording medium having, to control said guests' video game terminals, a program recorded thereon for causing said guests' video game terminals to receive said invitation signal and obtaining said setup information, create access request signals comprising said setup information, and transmit to said database, said access request signals solely in response to each guest's instruction.

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EVIDENCE APPENDIX

None

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RELATED PROCEEDINGS APPENDIX

None